

REMARKS

Claims 1-37 are pending in the application. Claims 1, 8, 10, 17, 19, 26, 28, and 36 have been previously amended to correct minor informalities in the claims. The Specification has also been previously amended to correct the Cross Reference to Related Application section. Consideration of the following Remarks is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

Claims 1-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goshey et al., U.S. Patent No. 6,205,527 (Goshey) in view of Fletcher et al., U.S. Patent No. 6,009,274 (Fletcher). Applicant respectfully traverses this rejection for the following reasons.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 citing *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Applicant respectfully maintains that the Examiner has failed to establish *prima facie* obviousness of the present invention since neither Goshey nor Fletcher, either alone or in combination, disclose, teach or suggest the use of a restore medium capable of being read by an information handling system, wherein the restore medium includes a program of instructions for initiating a connection with a network storage medium over a network as variously claimed in independent claims 1, 10, 19 and 28.

When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. See MPEP § 2141 and *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Applicant maintains that there exists no reason, suggestion, or motivation from the prior art for modifying the teaching Goshey or Fletcher to provide the restore medium of the presently claimed invention as required by MPEP § 2141. In responding to Applicant's arguments, the Examiner states that the motivation for combining Goshey with Fletcher is "that when installing application on a computer system, it is advantageous to update the software with the newest drivers and updates available, to prevent flaws in the software from causing further damage." Applicant respectfully disagrees. As previously argued, Goshey teaches an intelligent backup system for backing up selected data from a host computer's main storage drive to prevent loss of data or user productivity using a peripheral storage device connected to the computer system, while Fletcher teaches a method and apparatus for automatically updating software components in one or more agents (end system) in a network. Goshey does not discuss initiating a connection with a network storage medium over a network, and thus provides no motivation for such a connection. Fletcher does not address the use of a restore medium and thus provides no motivation for providing a restore medium. Consequently, neither Goshey nor Fletcher may be relied upon to furnish motivation for their combination. As a result, it is believed that the Examiner has impermissibly relied upon Applicant's specification for motivation currently of record for combination these references to provide a restore medium having a set of instructions for initiating connection to a network storage medium for restoring an information handling system. Accordingly, Applicant again submits that a *prima facie* case of obviousness of claims 1-37 has not been established. Withdrawal of the rejections of these claims under 35 U.S.C. § 103 is therefore respectfully requested.

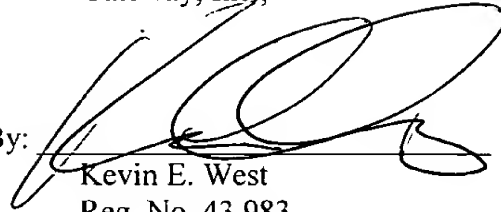
CONCLUSION

The application is respectfully submitted to be in condition for allowance of all claims. Accordingly, notification to that effect is earnestly solicited.

Respectfully submitted,
Gateway, Inc.,

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By:

A large, stylized handwritten signature in black ink, appearing to read 'Kevin E. West', written over a horizontal line.

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